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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

000026-00030

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Application Number

09/890,581

Filed

March 8, 2002

First Named Inventor

Ian Trevor DAMPNEY et al.

Art Unit

3731

Examiner

Nguyen, VI X.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

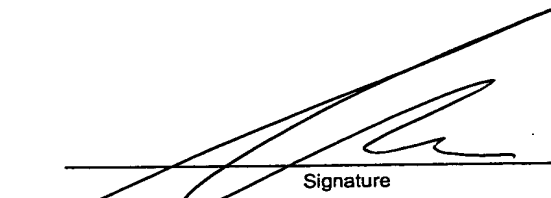
I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record. 28,419  
Registration number \_\_\_\_\_

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Michael C. Greenbaum

Typed or printed name

202-772-5800

Telephone number

August 9, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	<u>PATENT</u>
Ian Trevor DAMPNEY et al.	:	Confirmation No. 6516
Serial No.: 09/890,581	:	Docket No. 000026-00030
Filed: March 8, 2002	:	Customer No. 27557
For: ACTUATING AND LOCKING MECHANISM FOR A SURGICAL TOOL	:	Art Unit: 3731
	:	Examiner: Nguyen, VI X.

**REQUEST FOR REVIEW PRE-APPEAL BRIEF**

**Mail Stop AF**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the May 11, 2005 final Office Action, Applicants request review of the Remarks below in conjunction with Applicants' Notice of Appeal before the filing of the Appeal Brief.

## **REMARKS**

Claims 1-9, 11-15, 17-27 are pending in this application with claims 1 and 11 being independent. In the May 11, 2005 Office Action, claims 1-9, 17-22 and 26-27 are finally rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,355,871 to Hurley et al. (hereinafter “Hurley et al.”). Also, claims 11-15 and 23-25 remain allowed.

The rejection under 35 U.S.C. § 102(b) is respectfully traversed because Hurley et al. fails to disclose, teach or suggest a collapsible cage having interdigitating actuating pads, as recited in independent claim 1. The rejection is addressed in detail below.

### **Claim Rejections – 35 U.S.C. § 102**

Claims 1-9, 17-22 and 26-27 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Hurley et al. Hurley et al. is interpreted as disclosing a surgical device including an actuating device 104 having an actuator surface 105 with a collapsible cage, as seen in Fig. 2. The Examiner suggests that the ribs 107 of the cage are inherently interdigitating actuating pads and therefore meet the claimed invention.

Applicants respectfully disagree with the Examiner’s interpretation of Hurley et al. Hurley et al. discloses a body controller 100 that is moveable between first and second positions. A flexible means 105 of the controller of Hurley et al. includes a series of radially spaced, laterally positioned ribs 107 (see col. 2, lines 59-61). The thumb is applied to the flexible means 105 to compress the inner wall and engage the top surface of the ribs 107, thus causing the ribs to elongate, thereby moving the body to the second position. Contrary to the Examiner’s suggestion, the ribs 107 of Hurley et al. are not interdigitating or interleaved but are instead spaced from one another, as seen in Figs. 2 and 3.

Moreover, no objective evidence or cogent technical reasoning supporting the conclusion that the ribs 107 of Hurley et al. are inherently interdigitating has been provided,

as required by MPEP § 2112. In fact, because the ribs 107 of Hurley et al. are spaced from one another, one skilled in the art would conclude that the ribs cannot be interdigitating.

Anticipation requires that every limitation of a claim must identically appear in a prior art reference. See *Gechter v. Davidson*, 43 U.S.P.Q. 2d 1030, 1032 (Fed. Cir. 1997). It is clear that the limitation of interdigitating actuating pads does not identically appear in Barnes et al. Absence from the prior art reference of any claimed element negates anticipation. See *Rowe v. Dror*, 42 U.S.P.Q.2d 1550, 1553 (Fed. Cir. 1997).

In view of the above, Applicants submit that claim 1 is not anticipated by Hurley et al. Dependent claims 2-9, 17-22, 26 and 27 are also not anticipated by Hurley et al. Moreover, those claims recite additional features that further distinguish them from the prior art including Hurley et al. For example, claim 2 recites that each pad has an inwardly extending groove and that the actuating device has a plurality of radially extending guides which engage a respective groove of each pad, and claim 7 recites that the actuating mechanism includes an override means for returning the actuating device from its actuated position to its rest position.

\* \* \*

For all the reasons stated above, Applicants request reconsideration and withdrawal of the Examiner's rejection as noted above and the issuance of a Notice of Allowability.

A Notice of Appeal and the required \$500 fee are submitted herewith. The Commissioner is hereby authorized to charge any additional fees due or any overpayment of fees to Deposit Account No. 23-2185 (000026-00030).

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael C. Greenbaum', is written over a horizontal line.

Michael C. Greenbaum  
Reg. No. 28,419

Attorney for the Applicant-Appellant

BLANK ROME LLP  
Watergate  
600 New Hampshire Ave., N.W.  
Washington, D.C. 20037  
Telephone: (202) 772-5800

Date: August 9, 2005